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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,954	06/17/2005	Oliver Schmitz	13195-00006-US	8865

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CONNOLLY BOVE LODGE & HUTZ, LLP  
P O BOX 2207  
WILMINGTON, DE 19899

EXAMINER
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CHOWDHURY, IQBAL HOSSAIN

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,954	<b>Applicant(s)</b> SCHMITZ ET AL.	
	<b>Examiner</b> Iqbal H. Chowdhury, Ph.D.	<b>Art Unit</b> 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

This application is a 371 of PCT/EP03/14649.

The preliminary amendment filed June 17, 2006 amending claims 7-12, 14-20 and 24 has been entered.

Claims 1-25 are pending.

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group, I claim(s) 1-2, 4-17, drawn to a process for preparing amino acids in an organism comprising introducing a gene encoding threonine degrading protein.

Group, II claim(s) 1, 3, 4-17, drawn to a process for preparing amino acids in an organism comprising introducing a gene encoding lysine degrading protein.

Group, III claim(s) 18-19, 20-23, drawn to a nucleic acid construct comprising a gene encoding a threonine degrading protein.

Group, IV claim(s) 18-19, 20-23, drawn to a nucleic acid construct comprising a gene encoding a lysine degrading protein.

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Group, V claim(s) 24, drawn to a process for producing animal food, cosmetics or pharmaceuticals by using transgenic organism.

Group, VI claim(s) 25, drawn to a polypeptide.

For each inventions I-VI above, restriction to one of the following is also required under 35 U.S.C. 121 and 372. Therefore, election is required of one of inventions I-VI and one of inventions (A) – (Q).

- (A). protein of SEQ ID NO: 2 or a nucleic acid encoding SEQ ID NO: 2.
- (B). protein of SEQ ID NO: 3 or a nucleic acid encoding SEQ ID NO: 3.
- (C). protein of SEQ ID NO: 4 or a nucleic acid encoding SEQ ID NO: 4.
- (D). protein of SEQ ID NO: 5 or a nucleic acid encoding SEQ ID NO: 5.
- (E). protein of SEQ ID NO: 6 or a nucleic acid encoding SEQ ID NO: 6.
- (F). protein of SEQ ID NO: 7 or a nucleic acid encoding SEQ ID NO: 7.
- (G). protein of SEQ ID NO: 8 or a nucleic acid encoding SEQ ID NO: 8.
- (H). protein of SEQ ID NO: 9 or a nucleic acid encoding SEQ ID NO: 9.
- (I). protein of SEQ ID NO: 10 or a nucleic acid encoding SEQ ID NO: 10.
- (J). protein of SEQ ID NO: 12 or a nucleic acid encoding SEQ ID NO: 12.
- (K). protein of SEQ ID NO: 14 or a nucleic acid encoding SEQ ID NO: 14.
- (L). protein of SEQ ID NO: 16 or a nucleic acid encoding SEQ ID NO: 16.
- (M). protein of SEQ ID NO: 18 or a nucleic acid encoding SEQ ID NO: 18.
- (N). protein of SEQ ID NO: 20 or a nucleic acid encoding SEQ ID NO: 20.
- (O). protein of SEQ ID NO: 22 or a nucleic acid encoding SEQ ID NO: 22.

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(P). protein of SEQ ID NO: 24 or a nucleic acid encoding SEQ ID NO: 24.

(Q). protein of SEQ ID NO: 26 or a nucleic acid encoding SEQ ID NO: 26.

2. The inventions listed as Groups I - VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The polynucleotide encoding a polypeptide threonine degrading protein of Group III and lysine degrading protein of Group IV, polypeptide of Group V, are each unrelated and chemically distinct entities. The only shared technical feature of these groups is that they all relate to polynucleotide encoding a threonine degrading protein and a lysine degrading protein. However, this shared technical feature is not a "special technical feature" as defined by PCT Rule 13.2 as it does not define a contribution over the art. According to the search report (PCT form 210), a DNA encoding a threonine aldolase (Monschau et al. "Threonine aldolase overexpression plus threonine supplementation enhanced riboflavin production in *Ashbya gossypii*", Appl Environ Microbiol. 1998 Nov; 64(11): 4283-90, see IDS) and lysine decarboxylase gene encoding protein (GenBank Accession No. AAL52676, LYSINE DECARBOXYLASE [*Brucella melitensis* 16M], created 12/27/2001). Thus, a DNA encoding a threonine aldolase and lysine decarboxylase proteins do not make contribution over the prior art.

3. The polypeptide of Group VI does not share any "special technical feature" with methods of Groups I, II or V as the polypeptide of Group VI is neither made nor used by the methods of Groups I, II or VI.

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4. The polynucleotide of Groups III or IV does not share any "special technical feature" with method of Group V as the polynucleotides of Group III or IV are neither made nor used by the method of Group V.

5. The methods of Groups I, II and V do not have unity of invention with each other as each methods comprises unrelated steps, use different products and produce different effects.

6. The nucleic acid and proteins of Group (A)-(Q) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different nucleotides encoding proteins of Group (A)-(Q), which are polypeptides of threonine aldolase or lysine decarboxylase, do not have special technical feature among each other because they all represent structurally different polypeptides and polynucleotide encoding them. As mentioned above, a DNA encoding a polypeptide threonine aldolase or lysine decarboxylase is known in the art and does not make contribution over the prior art. Therefore, they all lack special technical feature.

A telephone call was made to Robert M. D. Makowski, on 10/18/2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

37 CFR 1.475 does not provide for multiple products and/or methods within a single application. Therefore, inventions of Group I - VI lack unity of invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iqbal Chowdhury whose telephone number is 571-272-8137. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,

Iqbal Chowdhury, PhD, Patent Examiner  
Art Unit 1652 (Recombinant Enzymes)  
US Patent and Trademark Office  
Rm. REM 2B69, Mail Box. 2C70  
Ph. (571)-272-8137, Fax. (571)-273-8137

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REBECCA E. PROUTY  
PRIMARY EXAMINER  
GROUP 1800  
1600